

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 7 and 28 have been cancelled without prejudice or disclaimer, claims 1, 3, 4, 5, 6, 11, 12, 13 and 27 have been amended and claim 29 has been added. Support for the new claim and the claim amendments may be found at least at paragraphs [0025] and [0026], and therefore no new matter has been presented.

Claims 1, 2, 4-6, 8-27 and 29 are pending and under consideration.

TRANSLATION OF FOREIGN REFERENCE REQUESTED:

"If a document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection" (MPEP 706.02, section II (emphasis added)). The machine-translated copy of Werner currently provided is incomplete and has numerous translation errors. As stated in the disclaimer found in the document header, the machine translation "is not a replacement for professional translation services." Based on the foregoing, Applicant respectfully requests a translation of the cited reference in any future office action relying on the same in order to demonstrate that Werner fails to anticipate or render obvious the claims of the present application.

OBJECTION TO THE DRAWINGS:

At page 2 of the Office Action the drawings were objected to under 37 CFR 1.84(p)(5), because reference character 436 in FIG. 4A is not described in the written description. In response, Applicant has amended paragraph [0031] to correct the omission. Accordingly, the outstanding drawing objections should be resolved.

Reconsideration and withdrawal of the outstanding objection to the drawings is respectfully requested.

OBJECTION TO THE SPECIFICATION:

At page 2 of the Office Action, paragraph [0031] of the written description was objected to. In response, Applicant has amended paragraph [0031] to correct the omission.

Reconsideration and withdrawal of the outstanding objection is requested.

CLAIM OBJECTIONS:

Claim 27 stands objected to due to an informality.

In response, Applicant has amended claim 27 to address the objection and to clarify the recitations. Accordingly, it is respectfully requested these objections be withdrawn.

REJECTION UNDER 35 U.S.C. §101:

Claims 19 and 20 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is traversed and reconsideration is requested.

Applicant asserts claims 19 and 20 are statutory per se because signals are an article of manufacture. The Supreme Court has interpreted the term “manufacture” in accordance with its dictionary definition to mean ‘the production of articles for use from raw or prepared materials by giving these materials new forms, qualities, properties or combinations, whether by hand-labor or machinery.’” *Diamond V. Chakrabarty*, 447 U.S. 303, 308 (1980)(Quoting *Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)). As the *Chakrabarty* Court observed, the “expansive” scope of the term “manufacture” reflects Congress’s intent that patentable subject matter “include[s] anything under the sun that is made by man.” *Id.* at 308-09 (quoting S. Rep No. 82-2979 at 5 (1952); H.R. Rep No. 82-1923 at 6 (1952)).

The Court’s broad definition of manufacture encompasses electrical signals, which are things made by man. In the electrical arts, a machine, such as a computer produces a signal using electricity (*i.e.* electrons) to carry information. See Harry Newton, *Newton’s Telecom Dictionary* 622 (17th Ed. 2001)(explaining that a signal may be “[a]n electrical wave used to convey information”). The machine transforms the signal into a useful carrier of information by encoding the signal with data through any of a plethora of techniques. Thus, the creation of an electrical signal meets the *Chakrabarty* Court’s definition of manufacture: producing a signal from electricity (*i.e.*, electrons) by giving the electricity new forms, qualities and properties through the data encoding process, where the production occurs by a machine. See *Diamond V. Chakrabarty*, 447 U.S. at 308; see also *Dolbear v. Am. Bell Tel. Co.*, 126 U.S. 1, 533-35 (1888)(holding that claims to the use of electricity to carry vocal sounds – *i.e.*, information – were patentable).

Accordingly, it is respectfully requested the rejection of claims 19 and 20 be withdrawn.

REJECTIONS UNDER 35 USC 102 and 103:

Claims 1-6, 11, 13-14, 19-21 and 27-28 stand rejected under 35 U.S.C. 102(b) as being anticipated by DE 10114950 to Goertz Werner ("Werner"). Claims 7-10, 12, 15-18 and 22-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Werner in view of U.S. Patent No. 5,920,826 to Metso et al. ("Metso"). The rejections are respectfully traversed.

Amended independent claim 1 recites at least the following features:

automatically storing the received SMS short messages in a memory region; and

automatically printing the received SMS short messages

Werner and Metso, taken separately or in combination, do not suggest or disclose at least the above-recited features.

The Office Action asserts that Werner describes "storing the received SMS short messages in a memory region" at lines 35-37 of page 2. Applicant respectfully disagrees.

Lines 35-37 of Werner state:

"In reverse direction dispatching one in the fax equipment FAX to in-output unit I/O is made for example via input by a keyboard provided and/or by reading in one with a short message SMS printed on sheet, if necessary with intermediate storage in a memory of the fax equipment FAX."

The above-cited text refers to the sending of messages from a fax machine to an external device via an I/O unit, as evidenced by the beginning of the paragraph which states "In reverse direction." Thus, the storage described above refers to the storing of messages to be sent by the fax machine (as an alternative to entering messages by keyboard). This is not the same as "storing the received SMS short messages."

Further, Werner does not describe "automatically printing the received SMS short messages as recited above."

Metso is directed to a communication system for transmitting text messages to a mobile terminal in a radio telephone network. Metso does not suggest or disclose a technique for managing short messages in a facsimile machine. Metso describes the storing of SMS messages using a personal computer at col. 13, lines 9-12. However, Metso fails to suggest or disclose "automatically storing the received SMS short messages in a memory region."

With regard to the printing of short messages, Metso states at col. 10, line 8:

“When the SMS page 800 has been selected, via the vertical button bar for example, the window described in FIG. 8 will appear. On this page the user is able to send, reply, forward, print and delete short messages.”

Thus, Metso requires user intervention to print messages and does not suggest or disclose “automatically printing the received SMS short messages” as recited above.”

Accordingly, Applicant respectfully submits that amended independent claim 1 patentably distinguishes over the cited references, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claims 13 and 23, with potentially differing scope and breadth, are not taught or disclosed by the references, the rejection should be withdrawn and claims 13 and 23 also allowed.

Further, Applicant respectfully submits that claims 2, 4-6, 8-12, 14-20 and 24-27, which variously depend from independent claims 1, 13 and 23, should be allowable for at least the same reasons as claims 1, 13 and 23, as well as for the additional features recited therein.

Independent claim 21 recites at least the following features:

A short message service (SMS) printing apparatus, comprising a programmed computer processor setting up a call to the SMS

The Office Action appears to note on page 6 that Werner fails to suggest or disclose all of the above-identified features. Therefore, Werner does not anticipate the claim because “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (*MPEP* 2131). The Office Action also fails to identify any portion of Metso that suggests or discloses the above-identified features. Thus, Applicant further submits that the rejection fails to establish a prima facie case of obviousness because the references must teach or suggest all the claim limitations. (*MPEP* 2143.01).

Accordingly, Applicant respectfully submits that independent claim 21 patentably distinguishes over the cited references, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claim 27, with potentially differing scope and breadth, are not taught or disclosed by the references, the rejection should be withdrawn and claim 27 also allowed.

Further, Applicant respectfully submits that claim 22, which depends from independent claim 21, should be allowable for at least the same reasons as claim 21, as well as for the additional features recited therein.

No Motivation to Combine

Applicant submits that the Office Action also fails to set forth a particular explanation as to why one of ordinary skill in the art at the time the invention was made would have been motivated to combine or modify Werner in view of Metso. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 SCt 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, one “must ask whether the improvement is more than the predictable use of prior art elements according to their established functions” slip op. 13, 82 USPQ2d at 1396. Furthermore, it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed” slip op. 14, 82 USPQ2d at 1396.

In rejecting claims 7-10, 12, 15-18 and 22-26, the only “reasons” given for combining Werner and Metso were to save memory space for future receptions, “thus making the system dynamically efficient and thus making it cost efficient” (Office Action, pages 8 and 10) and to allow the user “to make selections and to take decisions as to whether or not to print something, thus adding user-friendly functionality and improving the performance of the system” (Office Action, page 9). It is submitted that these reasons are insufficient to answer the question posed by *KSR v. Teleflex*, i.e., whether these claims recite a predictable use of established functions of the devices disclosed in Werner and Metso.

As discussed above, Werner is directed to fax equipment which receives short messages and Metso is directed to a communication system for transmitting text messages to a mobile terminal in a radio telephone network. The Office Action fails to cite anything suggesting that one of ordinary skill in the art would find it obvious to use the radio telephone communication techniques of Metso in a facsimile machine. In short, there is nothing in the prior art to make predictable the combination of Werner and Metso in the manner used in rejecting the claims. It is submitted that only the template provided by the claims themselves made the combination of these references seem obvious to the Examiner.

Accordingly, claims 1, 2, 4-6, 8-27 and 29 should be allowed for all of the foregoing reasons.

NEW CLAIM:

New claim 29 is directed to method of managing short messages in a facsimile machine or a multifunctional device having a short message service. Therefore, it is submitted that claim 29 patentably distinguishes over the prior art.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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